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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/324,511	06/03/1999	HARUHISA SUZUKI	35.G2398	1647

5514 7590 04/01/2002

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EXAMINER

O CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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2167

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DATE MAILED: 04/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/324,511

Applicant(s)
Suzuki et al.

Examiner
O'Connor

Art Unit
2167



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 14, 2002 (Amendment "A")
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-65 is/are pending in the application.
- 4a) Of the above, claim(s) 22-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Preliminary Remarks

1. This Office Action has been prepared in response to the amendment and arguments filed by applicant on January 14, 2002 (Paper N^o 9), in response to the prior Office Action.
2. The cancellation of claims 1-21, and the addition of new claims 59-65, are hereby acknowledged.
3. Claims 22-58 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper N^o 6.

Claim Rejections - 35 USC § 112, Second Paragraph

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 59-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding apparatus claims 59-63 and 65, the claims are indefinite for the excessive use of functional and/or operational language. The manner of operating a device does not differentiate an apparatus claim from the prior art. Therefore, apparatus claims which recite such extraneous limitations in a substantive manner (beyond the mere setting of context of the invention) are considered indefinite, since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired, in that a question or doubt is raised as to whether applicant considers features introduced by such language to be, (a) merely exemplary of the usage of the device, and therefore not required, or (b) a required feature of the claims. See MPEP § 2114.

Regarding claim 61, it is unclear if the recitation "a service" is referring to "the service" or to some other service. Moreover, it is unclear to which price of "the plurality of prices" the recitation of "the price" is intended to refer.

Additionally, the claims are also indefinite because the following recitations, found therein, lack a sufficient antecedent basis:

- In claim 62, line 2: "said information processing system";
- In claim 63, line 3: "the price unique to one shop";
- In claim 64, line 3: "said first storage means";
- In claim 65, line 4: "said first storage means".

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 59-65, as best understood in light of their rejection under 35 U.S.C. 112, hereinabove, are also rejected under 35 U.S.C. 102(b) as being clearly anticipated by each of Waterhouse et al. and DeTemple et al.

8. Claims 59-65, as best understood in light of their rejection under 35 U.S.C. 112, hereinabove, are also rejected under 35 U.S.C. 102(e) as being clearly anticipated by each of Goodwin and Zimmerman.

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 59-65, as best understood in light of their rejection under 35 U.S.C. 112, hereinabove, are also rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art.

In the background of the invention, the specification describes that it is previously known to manage different groups of shops having different rate structures. See, for example, lines 10-17 on page 2. The instant invention is merely to provide a mechanical system whereby the existing manual process can be performed better and more easily through the implementation of automation.

However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have automated the known manual process, in order to improve the speed and the reliability of the process while concomitantly reducing the level of manual effort required, since it is well settled that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

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Response to Arguments

11. Applicant's arguments filed January 14, 2002 have been fully considered but they are not persuasive.

12. In response to applicant's arguments that the intended uses of the applied prior art devices differ from that of applicant's device, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In this case all that is required to meet the limitations of, for example, claim 59, is a device with "a first storage means" and "a second storage means," which requirement all of the applied prior art references meet.

13. Regarding the rejection of the claims under 35 U.S.C. 103, applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

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Conclusion

14. The prior art made of record and not relied upon is considered pertinent to the disclosure.

15. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).


Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525.

GJOC

March 27, 2002


ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600-2100